

REMARKS

Reconsideration and withdrawal of the rejections of the claimed invention is respectfully requested in view of the amendments, remarks and enclosures herewith, which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

With the cancellation of claims 7-10, claims 1-6 and 11-15 are now pending in this application. New claims 11-15 have been incorporated to claim narrower embodiments of the invention. No new matter has been added by this amendment.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. THE 35 U.S.C. 101 REJECTION HAS BEEN OVERCOME

Claim 7 was rejected as allegedly being an improper process claim. This rejection has been rendered moot by the cancellation of claim 7.

III. THE 35 U.S.C. 112, 2nd PARAGRAPH REJECTION HAS BEEN OVERCOME

Claims 2-7 were rejected as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regards as the invention. The applicants request reconsideration of this rejection for the following reasons.

1. Although believed to be redundant, the applicants have inserted the term “agriculturally acceptable” in dependent claims 2-6 (redundant because by definition, claims 2-6 incorporate all of the limitations of claim 1 including the phrase “agriculturally acceptable”)
2. (“First of all...”) Claim 4 has been amended to insert the conjunction “or” between process steps a, b, c and d. (“Secondly”) Although believed to be redundant as one of ordinary skill in the art would understand that because the starting material is R⁴ and R⁵ is H, that the R⁴ and R⁵ would not be H for the alkylating agent, the applicants have inserted language into the claim making this explicitly clear. (“Thirdly”) This rejection is not well understood as the scope of the claim does not appear to be in question, but appears to be directed toward whether “haloalkyl” is enabled, i.e. a first paragraph rejection. If this was the intent, the rejection should

be made under the appropriate paragraph (as a pre-emptive matter, the applicants note that one of ordinary skill in the art would be able to practice haloalkyl as an alkylating agent. First, if the alkylating agent contains a more reactive leaving group than the halogen, then the haloalkyl group can be selectively introduced to the R⁴ or R⁵ position. Second, if the alkylating agent contains two reactive group (e.g. two halogens), then the reaction can be driven towards a monosubstitution product by using an excess of alkylating agent). Third, it is not necessary for each and every possible embodiment to work in order to be considered enabled¹.).

3. The rejection of claim 7 has been rendered moot by its cancellation.

IV. THE 35 U.S.C. 102(b) REJECTION HAS BEEN OVERCOME

Claims 1-7 were rejected as allegedly being anticipated by Saito et al., EP 0864567-“Saito.” However, “An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed in the prior art and that such existence would be recognized by persons of ordinary skill in the field of the invention.” see *In re Spada*, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); *Diversitech Corp. v. Centurry Steps, Inc.*, 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988). The applicants request reconsideration of this rejection because Saito fails to describe the applicants’ claimed invention with “sufficient clarity and detail”.

While there is some general overlap between the triazine compounds of Saito and the compounds presently claimed, Saito lacks any teaching or direction with respect to specific stereochemistry much less specific stereochemistry with respect to a 1R-compound and having a stereochemical purity at this chiral center of from 60 to 100% (R).

The compounds of the present invention do not claim nor do they encompass the racemic mixtures taught by Saito and as such each and every limitation of the applicants’ claimed invention has not been taught. To the extent it could be speculated that Saito might teach specific stereoisomers, one of ordinary skill in the art would not find such a teaching to have sufficient clarity and detail for 1R-compound and having a stereochemical purity at this chiral center of from 60 to 100% (R). Therefore, the applicants’ claims are not anticipated.

¹ A disclosure of a large number of operable embodiments and the identification of a single inoperative embodiment did not render a claim broader than the enabled scope because undue experimentation was not involved in determining those embodiments that were operable. *In re Angstadt*, 537 F.2d 498, 502-503, 190 USPQ 214, 218 (CCPA 1976)

V. THE 35 U.S.C. 103(a) REJECTION HAS BEEN OVERCOME

Claims 1-7 were rejected as allegedly being obvious by Saito et al., EP 0864567- "Saito." The applicants request reconsideration of this rejection for the following reasons.

Claims 1-7 were rejected as allegedly being obvious by Lorenz et al. WO 97/31904- "Lorenz." The applicants request reconsideration of this rejection for the following reasons.

Both of the Saito and Lorenz rejections are similar to the rejections made above with respect to anticipation in that they are directed toward the general compound structure and not the stereochemistry. As Saito and Lorenz were presumably rejected to address the differences in the scope of the general compound structure, the applicants' arguments above also apply here, i.e. neither Saito nor Lorenz teach or suggest a *1R*-compound and having a stereochemical purity at this chiral center of from 60 to 100% (R).

VI. THE OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTION HAS BEEN OVERCOME

Claims 1-7 have been provisionally rejected under obviousness-type double patenting (ODP) over claims 1-9 of copending Application No. 10/368,856. When making a determination of obviousness for ODP, only the claims of the respective applications are compared against each other. When comparing the claims of the present application vs. the claims of the '856 application, at least three differences emerge: (1) the 5-position of the triazine ring in the present invention is substituted with -C(R¹)(R²)(R³) whereas the '856 application has -H; (2) the ring fused to the phenyl ring in the present invention is either a 5- or 6- membered ring which is narrower in scope than the ring described in the '856 application; (3) the present invention is directed toward a specific isomer, (*1R*).

Therefore, the presently claimed invention when comparing the respective claims are not an obvious variation of the claims of the '856 application.

CONCLUSION

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution. The Commission is authorized to charge any fee

occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

Respectfully submitted,
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